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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,493	11/28/2001	Martin Handfield	01-662	1452

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP  
300 S. WACKER DRIVE  
32ND FLOOR  
CHICAGO, IL 60606

EXAMINER

BASKAR, PADMAVATHI

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/995,493

Applicant(s)

HANDFIELD ET AL.

Examiner

Padmavathi v Baskar

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached note.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 15, 16 and 28.Claim(s) withdrawn from consideration: 1-14 and 17-27.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: see attached note

Applicant's response filed on 7/14/04 states that the examiner did not respond to claims 29-31 in the previous office action mailed on 5/19/04. Further, applicant states that the Office action mailed on 5/19/04 is in error and must be removed. The examiner would like to bring applicant's attention to the amendment mailed by applicant on 2/17/04. The amendment does not contain claims 29-31.

(please see the first page of 2/17/04 Amendment filed by applicant which states:

Remarks

The Amendments

Claims 15 and 28 have been amended solely to remove dependencies from non-elected claims. The amendments are not narrowing amendments.

Objection to Claims 15 and 28

Claims 15 and 28 stand as objected to as depending from non-elected claims.

Claims 15 and 28 have been amended so that they do not depend from non-elected claims. Applicants respectfully request removal of the objection----).


Please note that the amendment filed on 2/17/04 does not refer to new claims 29-31.

Therefore, the examiner rightly followed the Office policy in making the action final without making any new rejections and answering applicant's arguments to the elected invention claims 15-16 and 28. Thus, the Office action mailed on 5/19/04 is proper.

Applicant's after final amendment 7/14/04 is not entered. The newly added claims 29-37 have not been examined previously in the prosecution and therefore, raises new issues under 35 U.S.C. 112, first paragraph etc.

Applicant's request for reconsideration of art rejections under 35 U.S.C. 102 (b) is considered but does not place the application in condition for allowance because the broadly claimed invention in claims 15 and 28 reads on the prior art as the broadly claimed peptide comprising at least five amino acids of SEQ.ID.NO: 52 having no sufficient structure, function or property as explained above read on the disclosed method, claim 28 under 35 U.S.C. 102(b) as being anticipated by Flemmig et al 1996(Clinical and Diagnostic Laboratory Immunology; 3, 678-681) or by Ebersole et al 1995(J.Dent Res 74 (2) 658-666) and claims 15-16 under 35 U.S.C. 102(b) as being anticipated by Snyder et al 1991 EPO0439210 or EPO 0439211 or EPO0439212 or EPO 537830.

Claims 15-16 and 28 are broader because the claimed peptide comprising at least five amino acids of SEQ.ID.NO: 52 does not satisfy the written description guidelines because the immunogenic polypeptide comprising (open language) at least at least five amino acids of SEQ.ID.NO: 52 plus unlimited and unknown amino acids of SEQ.ID.NO: 52 would result in unknown immunogenic peptides without sufficient structure and completely lacking identifying characteristics such as function. Therefore, did not overcome the rejections under 35 U.S.C. 112, first paragraph, written description and enablement as explained previously.

  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1800